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|---|---------------|----------------------|---------------------|------------------|
| APPLICATION NO.   | FILING DATE   | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/567,199  | 08/14/2006    | Augusto Brazzini     | EXPL-004            | 9591             |
| 81163   | 7590          | 12/22/2011           | EXAMINER            |                  |
| LAW OFFICE OF ALAN W. CANNON<br>1999 South Bascom Ave., Suite 700<br>Campbell, CA 95008 |               |                      | MENDOZA, MICHAEL G  |                  |
| ART UNIT  | PAPER NUMBER  |                      |                     |                  |
|   | 3734          |                      |                     |                  |
| MAIL DATE   | DELIVERY MODE |                      |                     |                  |
| 12/22/2011  | PAPER         |                      |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |  |                        |                     |
|------------------------------|--|------------------------|---------------------|
| <b>Office Action Summary</b> |  | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              |  | 10/567,199             | BRAZZINI ET AL.     |
| <b>Examiner</b>              |  | <b>Art Unit</b>        |                     |
| MICHAEL MENDOZA              |  | 3734                   |                     |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on 20 October 2011.
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 5)  Claim(s) See Continuation Sheet is/are pending in the application.
- 5a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 6)  Claim(s) 112, 115-120, and 122 is/are allowed.
- 7)  Claim(s) 107-111 is/are rejected.
- 8)  Claim(s) \_\_\_\_\_ is/are objected to.
- 9)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 10)  The specification is objected to by the Examiner.
- 11)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a)  All    b)  Some \* c)  None of:  
 1.  Certified copies of the priority documents have been received.  
 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 9/6/11, 11/30/11
- 4)  Interview Summary (PTO-413)  
 Paper No(s)/Mail Date: \_\_\_\_\_
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1,6-10,12-16,31,33,35,37-39,41,42,44,45,50,52,53,55,59,62,64-72,74-76,78,79,84,86,88-95,104-120,122 and 125-151.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 1,6-10,12-16,31,33,35,37-39,41,42,44,45,50,52,53,55,59,62,64-72,74-76,78,79,84,86,88-95,104-106,113,114 and 124-151.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 107, 110, 112, and 115 have been considered but are moot in view of the new ground(s) of rejection. The applicant has amended the independent claims to include new limitations. The newly added limitations change the scope of the claims and require new consideration and an update search.
2. Claims 2-5, 11, 17-30, 32, 34, 36, 40, 43, 46-49, 51, 54, 56-58, 60, 61, 63, 73, 77, 80-83, 85, 87, 96-103, 121, and 123 are cancelled.
3. Claims 1, 6-10, 12-16, 31, 33, 35, 37-39, 41, 42, 44, 45, 50, 52, 53, 55, 59, 62, 64-72, 74-76, 78, 79, 84, 86, 88-95, 104-120, 122, and 125-151 are currently pending.
4. Claims 1, 6-10, 12-16, 31, 33, 35, 37-39, 41, 42, 44, 45, 50, 52, 53, 55, 59, 62, 64-72, 74-76, 78, 79, 84, 86, 88-95, 104-106, 113, 114, and 124-151 are withdrawn from consideration.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 107-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berson 4246893 in view of Duh et al. 5151086.

7. Berson teaches a method of treating obesity in a patient, the method comprising: making an opening in the abdominal cavity of the patient (col. 4, lines 54-56); passing an expandable device (2), while in a contracted configuration, through the opening; positioning the expandable device (2) adjacent the stomach of the patient (col. 4, lines 56-59); expanding the expandable device (col. 5, lines 19-22); and anchoring the expandable device(2), relative to at least one structure in the abdominal cavity (the expandable device is anchored to the abdomen via port 4 by attaching sutures 28 to tub 3 and nozzle 9); further comprising anchoring (suturing tabs 33 to the abdomen) an adjustment member (4) that is connected to the expandable member (2) via a conduit (3), to a portion of the patient's body; wherein the positioning comprises positioning the expandable device anteriorly of the stomach to occupy a space normally occupied by the stomach (fig. 5). It should be noted the Berson fails to teach puncturing the skin of the patient and making a percutaneous opening.

8. Duh et al. teaches a method including a step of accessing the abdominal cavity by puncturing the skin of the patient and making a percutaneous opening to reduce the invasiveness and trauma associated with open surgery (col. 1, lines 25-30). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Berson to include the step of puncturing the skin of the patient and making a percutaneous opening in view of Duh et al. as an alternative to open surgery to reduce the invasiveness and trauma associated with open surgery.

9. As to claims 111, Berson/Duh discloses the claimed invention except for wherein at least two locations on the expandable device are anchored to at least one structure in the abdominal cavity. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use more than one anchor, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Therefore, it would have been obvious to one of ordinary skill in the art to anchor the expandable device in more than one location to keep the expandable device more securely placed adjacent the stomach.

***Allowable Subject Matter***

10. Claims 112, 115-120, and 122 are allowable over the prior art of record.

11. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or render obvious the overall claimed method of treating obesity in a patient, the method comprising: positioning an expandable device adjacent the stomach of the patient; and anchoring the expandable device to at least one structure in the abdominal cavity, wherein the expandable device is drawn into contact with a location of the at least one structure that the expandable device is anchored to. Berson discloses a filling tube that is connected to a balloon and adjusting port. The adjusting port being anchored to fascia (abdomen). The filling tube is not used to drawn the balloon into contact with the fascia.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL MENDOZA whose telephone number is (571)272-4698. The examiner can normally be reached on Mon.-Fri. 10:00 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, ***please contact the examiner's supervisor, GARY JACKSON, at (571) 272-4697***. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

***If there are any inquiries that are not being addressed by first contacting the Examiner or the Supervisor, you may send an email inquiry to***

TC3700\_Workgroup\_D\_Inquiries@uspto.gov.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Mendoza  
/M. M./  
Examiner, Art Unit 3734  
December 17, 2011

/Gary Jackson/  
Supervisory Patent Examiner  
Art Unit 3734